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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1942.

No. 71.

UNITED CARBON COMPANY

AND

UNITED CARBON COMPANY, INC.,

Petitioners,

v.

BINNEY & SMITH COMPANY,

Respondent.

REPLY BRIEF FOR PETITIONERS.

Respondent's case, as we understand its brief, is:

That the claims here in issue cover any carbon black aggregates that are (R. 19)

(1) substantially pure;

(2) hard enough to handle;

(3) soft enough to disperse freely in the rubber mix; and

(4) "flowable".

That contention of respondent, though essential to respondent if it is to obtain a monopoly of all carbon black aggregates that can be used by the consuming industries, as the evidence shows it seeks to do,—is nevertheless in conflict with

(1) the differentiation made by Wiegand & Venuto in the patent in suit between the properties of their product and the product of the prior art;

(2) the cancellation by Wiegand & Venuto of certain of their original claims after their rejection by the Patent Office during the pendency of the application for the patent in suit.

Respondent would give to the claims in issue one construction for the purpose of determining their validity, and another construction for the purpose of determining their scope and infringement.

For the purpose of determining the validity of the claims, respondent differentiates the product of the patent in suit from the prior art by the particular phraseology of the claims and by the process by which the product of the patent is produced.

For the purposes of having its claims cover petitioners' product and all other carbon black agglomerates suitable for use by the consuming industries, respondent ignores those limitations and gives to its claims a scope of sufficient breadth to include the product of the prior art, and the claims rejected by the Patent Office and cancelled by Wiegand & Venuto in order to obtain their patent.

Respondent thus uses the indefiniteness of the terms of the claims to make of them a "nose of wax" to be turned as the exigencies of the moment would seem to require.

The Patent in Suit Refutes Respondent's Present Contention.

The "invention" disclosed in the patent in suit is quite different from the "invention" which respondent says petitioners are infringing. Petitioners' hard, single-liquid ag-

glomerates, now said to infringe the patent, are disparaged and condemned in the patent in suit. Examination of the patent in suit reveals that it refers to the fineness of carbon black powder, its lightness, its bulk, and its dustiness. It states that numerous attempts had been made to render it denser and less dusty; that in these attempts, the carbon black had been made with a single liquid; but that upon distilling or evaporating the liquid therefrom, the resulting product was hard and that the particles thereof did not disperse readily and uniformly in rubber compositions. (R. 228, lines 62-69.)

The main object of the invention, says the patent,

> "is to secure carbon black having the desired dispersive properties, greater density, freedom from dust, freedom from gritty particles * * * and capable of considerable handling without crushing or dusting."

Instead of the disparaged single-liquid process of the prior art, respondent's patent discloses a two-liquid flotation process, the product of which, says the patent,

is soft	R. 228, line 75
	R. 228, lines 63-65
	R. 228, lines 73-75
	R. 228, lines 86-87
	R. 228, lines 90-92
	R. 229, line 85
disperses freely	R. 228, line 92
is easily crushed	R. 228, line 86
is very porous	R. 229, line 80
is fragile under light pressure	R. 229, line 85
is easily reduced to soft, minute particles	R. 229, line 86

has a porous interior .....R. 229, line 93
is free from grit .....R. 228, line 65
R. 229, lines 100-105.

At R. 228, lines 83-90, the patent says that the pellets formed by the process

> "* * * are hard enough to stand any ordinary shipment or handling without dusting, flying or breaking down, and which at the same time are easily crushed by moderate pressure, as between the fingers or by the pressures commonly employed in the rolls of rubber-compounding machinery * * *".

The shape of the product, says the patent,

is not important * .....R. 228, lines 95-98
may be in the form of flakes ....R. 228, lines 98-100
may be pressed into blocks .....R. 229, lines 1-3
may be an amorphous mass ....R. 230, lines 74-77.

With respect to the size of its pellets, the patent says that

they "* * * will be of about one-sixteenth of an inch in diameter and will be fairly uniform in size" .....R. 229, lines 75-79

small or large pellets may be obtained by increasing or decreasing the amount of gasoline and increasing or decreasing agitation .....R. 230, lines 56-63.

The patent further states

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* Wiegand testified that he had seen "carbon black in spherical form before" he made his asserted invention. (R. 88)

that its invention can be applied to

> "other fine powders whose industrial applications depend upon their dispersibility. For example * * * certain talcs and clays * * *" . . R. 230, lines 107-111

that "carbon black" as used in the patent includes

> "lamp black, gas black and other black analagous carbon substances for use as pigments or fillers" . . . . . R. 230, lines 101-105.

The Claims.

The claims in suit define the product of the patent as:

(1) "Substantially pure carbon black". Whether this terminology is given the meaning stated in the patent as "freedom from gritty particles" (R. 228, line 65; R. 229, lines 100-105) or absence of a binder, as stated (R. 19) by Kitchel, respondent's president, is here immaterial. Knowlton & Hoffman's water-alone prior art product, like petitioners' Sayre product, contained no binder; but like petitioners' product, did contain all gritty particles that were in the carbon black powder of which the agglomerates were formed. The result is this:

If "purity" of respondent's Wiegand & Venuto product distinguishes that product from the product of the prior art, it likewise differentiates petitioners' product from that of Wiegand & Venuto.

(2) "Commercially uniform." Wiegand was asked to define "commercially uniform". He said (R. 91):

"A. By commercially uniform, I would say uniform enough to meet the requirements of commerce, in the sense that they are acceptable to our customers.

"Q. And to find out whether they are commercially uniform, you have got to *to* ship them to your customers and find out whether or not they will use them; is that right?

"A. I think that has got to be the ultimate and absolute test; yes, sir."

(3) "Comparatively small." Wiegand testified (R. 83):

"The Court: * * * You are just being asked what you meant by using that term in your testimony, from low to high, what do you mean by approximately one-sixteenth of an inch?

"A. * * * I have already said it certainly *ought not*, in my judgment, to *be bigger than a quarter of an inch*, probably, to serve its purpose, and *I would say to one one-hundredth of an inch.*"

(4) "Rounded, smooth aggregates." The patent states shape is not the most important characteristic (R. 228, lines 95-100); it may be in the form of flakes (R. 228, lines 98-100); pressed into blocks (R. 229, lines 1-3); or, an amorphous mass (R. 230, line 75).

Wiegand testified that he had seen carbon black in spherical form before he made his asserted invention (R. 88).

(5) "A spongy, porous interior." Putting carbon black powder into grains or pellets is but a form of packaging the carbon black without changing its properties when mixed with rubber. The span of usefulness of the package is only that of any other package. It begins after the carbon black is produced and ends when the packaged

product is put into use—in this instance, with the introduction of the carbon black into the rubber mix.

Dr. Drogin testified (R. 173-174):

"Q. And the quality of the rubber is not influenced in the least by the nature of the porosity of the pellets, is it?

"A. The quality of the rubber?

"Q. Yes, made with carbon black pellets. That is not changed at all by reason of the difference in the degree of porosity of the pellet, is it?

"A. Not that I know of.

"Q. *The essential thing is that* they be pellets of substantially pure carbon black and that *in the process they break down to the individual particles,* that is true, is it not?

"A. That is generally true."

Wiegand testified (R. 79-80):

"Q. • • • Now, what degree of sponginess and porosity do you think is necessary to embody your invention—is necessary for your invention, I will say?

"A. *Enough to provide the first characteristic of a successful carbon black.* Now, when you ask me to define the theoretical relationship between porosity and that all-important characteristic of disseminating through the rubber in such way that every particular individual particle of carbon black is lodged in its place in the rubber, which in my judgment is the prerequisite of this reinforcement, sir, that everybody wants—if you ask me to define the relationship between that dispersibility in rubber and porosity, I have got to admit my ignorance.

"Q. So you don't know?

"A. *I don't know where the borderline is;* no, sir. All I know is, if you have got—*if you are within the proper range your pellet does a proper job in the rubber factory.*"

And at R. 83:

> "Q. * * * Mr. Wiegand, can you give me *some* idea of where the dividing line is between porous and non-porous, as far as carbon black pellets are concerned?
>
> "A. I think I explained that we feel that porosity is the prerequsite to proper mixing or miscibility. *If the product disseminates and mixes in the rubber and produces the reinforcing effects,* for which carbon black is prized, my experience is that *those pellets have the necessary structure.*
>
> "Q. The only way to tell it is to try it then?
>
> "A. *That is the only way to tell* whether you have got the exact and necessary amount of internal looseness of structure, * * *."

At R. 221, Wiegand added:

> "Porosity causes friability."

"Friable" means, easily crushed. (Webster.)

But Knowlton & Hoffman's friable lumps or grains permit

> "A uniform distribution of the (carbon black) filler throughout the rubber." (R. 287, lines 29-31.)

A product may not be validly claimed in terms of function nor may a patentee broaden his product claims by describing the product in terms of function.*

Yet, Wiegand was unable to give limits or boundaries, otherwise than in terms of function, to the indefinite terms used in the claims.

The evidence thus seems to make obvious that if respondent's present contention is sound, the claims in issue are,

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Gen. Electric Co. v. Wabash Co., 304 U. S. 364.

(1) indefinite;

(2) so broad and elastic as to be functional;

(3) being used to assert a complete monopoly of carbon black in granular, lump or pellet form, by whatsoever process produced, and without regard to the non-functional characteristics thereof.

Respondent's Reversal of Position With Respect to What Its Patent and Claims Cover.

Respondent, now that it has its patent, no longer takes the position, asserted in the patent, that the product of the patent is *soft* while the product of the prior art was *hard*, but here asserts that the claims in suit cover any carbon black aggregates, however hard, that are usable by the rubber industry.

The statements of Wiegand (R. 78-80, 83, supra pages 7-8) are believed to be to that effect.

Kitchel, respondent's president, in addition to testifying (R. 19) that the essential characteristics of the Wiegand & Venuto product are (1) "purity", (2) hard enough to handle, (3) dispersibility, and (4) flowability, added:

> That any carbon black having those properties is the product of the patent..... R. 57-58
>
> That the beads made by the single liquid process and those made by the two-liquid process show no visible difference..... R. 49
>
> That the high density agglomerates which cannot be crushed between the fingers by normal pressure, made by the Cabot Company *by a dry process* under its patents Nos. 2,120,540 (R. 235), 2,120,541 (R. 239), Re. 19,750 (R. 248) and 2,039,766 (R. 258) to Billings & Offutt, come within the product claims here in issue..... R. 39-41

That the dense, free-flowing non-dusting product made by Huber Company *by a dry process* under its Patent to Price No. 2,127,137 (R. 271) likewise comes within the product claims here in issue..... R. 58

That a carbon black pellet satisfies the demands of the Wiegand & Venuto patent here in suit,—

> "A. If it is pure carbon and if it is hard enough and soft enough, and has that flowability and is relatively free from dust, I would say that it is.
>
> "Q. Do you find those properties of the dustless product of the Huber Company or the Cabot Company?
>
> "A. In general I see no difference." R. 57-58

The Claims as Here Construed by Respondent Cover the Product of the Prior Art.

The patent to Knowlton & Hoffman* (R. 287) describes and discloses two products,—one made by the water-alone process of Geer plus drying, which causes the concretion of the powder

> "into friable grains or small lumps, dry and substantially free from dust * * * the friability of the lumps or grains permitting a uniform distribution of the filler throughout the rubber". (R. 287, lines 23-31.)

That the product of their water-alone process is hard enough to handle, is made clear by their statement (R. 287, lines 25-28) that their product is incorporated with the rubber "in this form",—that is, in the form of friable

*None of the patents discussed under this caption, except the patent to Geer, was cited by the Patent Office.

grains or small lumps, dry and substantially free from dust.

In the process of Geer, which, with the addition of drying, is the process of Knowlton & Hoffman, the amount of water added to the carbon black is that amount which will render the carbon black "dustless but yet not pasty". (R. 289, lines 27-30.)

The other process and product of Knowlton & Hoffman includes the use of a binder and much more water. With that process and product, we are not here concerned. Obviously Knowlton & Hoffman's water-alone process cannot result in a "mud cake" as respondent contends. It is here immaterial whether the product of Knowlton & Hoffman's other process is or is not properly characterized as "mud cake".

The product of Knowlton & Hoffman thus has all the properties asserted for the product of the claims in suit, namely:

(1) Purity—if petitioners' product is pure, as neither removes grit.

(2) Flowability—the product of the Knowlton & Hoffman patent is in the form of grains or small lumps.

(3) It is hard enough to handle.

(4) It disperses freely in the rubber mix.

Patent to Coffin & Keen was for a method of converting pulverulent material, particularly clay, or other filler for rubber compounds, into the form of very small, individually dried, friable, globular masses or spherical friable pellets composed of lightly cohering particles of the material. (R. 298, lines 86-92.)

The product will flow very readily (R. 298, line 94);

"It is extremely fluent" (R. 298, line 103);

It "can be very readily handled" (R. 298, line 104);

It "may be conveyed by any suitable means or disposed for storage in any suitable manner" (R. 298, lines 98-100);

"A very slight pressure, such as that of the fingers is sufficient to crush the grains, but the bond between the particles is sufficiently strong to substantially prevent their breaking up during handling." (R. 298, lines 125-130);

The invention is applicable to "other rubber fillers * * * in which objectionable dusting occurs in handling." (R. 299, lines 16-21.)

Coffin & Keen dealt specifically with "spherical friable pellets"* of dried clay or "other rubber fillers * * * in which objectionable dusting occurs in handling".**

Carbon black is such a rubber filler.

The carbon black pellets described in the patent in suit have the identical attributes which Coffin & Keen disclose for their product.

Can there be invention, then, in a carbon black pellet having the attributes of the product of Coffin & Keen? We believe that question was answered in the negative, by this Court, in *Glue Co. v. Upton*, 97 U. S. 3, 6, when it said:

> "Where certain properties are known to belong generally to classes of articles there can be no invention in putting a new species of the class in a condition for the development of its properties similar to that in which other species of the same class have been placed for similar development."

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*R. 299, Claim 8.

**R. 299, lines 18-21.

As the conception of agglomerated rubber fillers possessing those attributes long antedated the advent of Wiegand & Venuto, the existence of patentable novelty in the claims in suit would seem to be further negatived by

Cohn v. United States Corset Company, 93 U. S. 366, 370, 377;
General Electric Co. v. deForest Radio (CCA-3) 28 Fed. (2d) 641;
Bisight v. One-Piece Bifocal Lens Co. (CCA-4) 259 Fed. 275;
One-Piece Bifocal Lens Co. v. Bisight, 246 Fed. 450, 454-459;
In Re Decker, 36 App. D. C. 104;
In Re Marden, 48 Fed. (2d) 428;
In Re Fink, 62 Fed. (2d) 103, 104.

When one patents that which is old, he makes no contribution of anything to the public. He gives no consideration for his monopoly. On the contrary, he takes from the public and would monopolize for himself, that which the public already has. Such patents are a public burden—not a public benefit. They are unjustifiable, either legally or economically. They are wholly void.

So, too, if one obtains a patent for that which is in the skill of the art, that, also, is in the public domain. The public may not be deprived by Letters Patent of that which, in that manner, is already in its possession.

The law with respect to these propositions has recently been vigorously reaffirmed by this Court in the *Cuno* case, 314 U. S. 84.

Consequently, petitioners earnestly urge that for each of the several reasons hereinbefore set forth, the claims

here in issue are wholly wanting in both novelty and invention.

Respondent's Asserted Commercial Success Is Wholly Illusory.

Respondent would seem to base its contention with regard to commercial success, not upon the two-liquid product of Wiegand & Venuto, but upon the commercial success of a water-alone product made by Columbian Carbon Company under Columbian's Glaxner patent.*

Moreover, it would seem that respondent cannot successfully assert commercial success for the two-liquid product of Wiegand & Venuto, in that during the first four years (1928 to 1931 inclusive) after the patent in suit was applied for, respondent distributed, by samples and on a "billing basis" together, only 383,000 pounds of its two-liquid product (R. 50-51). Since 1931, no one in the industry has used the two-liquid process of Wiegand & Venuto.

In 1932, respondent became sales agent for the product made by Columbian Carbon Company (R. 57) under Columbian's Glaxner product, (Re. 21,379, R. 263).

The product sold by respondent in 1932 was not made by the Wiegand & Venuto process (R. 56).

The Glaxner process and product are the process and product of Geer and of Knowlton & Hoffman. Glaxner states:

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*The Glaxner patent was applied for November 6, 1933 (R. 263) which was after the Cabot Company had begun the shipment of its hard pellets in tank cars and had installed closed conveyor systems in the Firestone Plant at Akron, Ohio, (R. 149) and in another plant.

That his process involves "merely the addition of water to the black, mechanical agitation, and drying" ..... R. 264, lines 45-47.

That he uses about equal amounts by weight of carbon black and water .... R. 265, second col., lines 12-15.

That a lump of wetted carbon black mix at the center of his first tube "should be almost stiff enough to break instead of being of a plastic and sticky consistency" ..... R. 265, lines 20-24.

That the shafts of both cylinders rotate at about 70 R. P. M. ..... R. 265, 1st col., line 75.

That his aggregates may be dried in any conventional manner ..... R. 266, first col., lines 19-22.

The water-alone process of Geer and Knowlton & Hoffman involves:

Merely the addition of water to the black, mechanical agitation and drying R. 289. R. 287, lines 31-36, 58-63.

The use of enough water to render "the gas black dustless and yet not pasty when mixed therewith in suitable proportions" ..... R. 289, lines 25-30.

"* * *. the wetting of the particles and their concretion into grains, * * *" .. R. 289, lines 20-24.

"* * * concretion into friable grains or small lumps, dry and substantially free from dust * * *" ..... R. 287, lines 23-25.

The incorporation with the rubber of the carbon black in the "form" of "friable grains or small lumps, dry and substantially free from dust" ..... R. 287, lines 23-26.

The use of agitation, in that the process is carried out "in a suitable closed vessel which preferably contains *rapidly-revolving* paddles which assist the mixing and promote the attainment of the granular condition" ..... R. 289, lines 32-35.

In DX-20, page 20 (a booklet entitled "Flow Carbon", copyrighted 1937 by respondent) respondent would vindicate its discontinuance of its two-liquid process. It said:

"* * * there had to be considered the increased cost of the two-liquid method, *and the fact that in the case of rubber carbons exceedingly high shearing forces were available for dispensing the carbon.*"

The commercial success of the Geer—Knowlton & Hoffman (Glaxner) product is no evidence, it is believed, of the commercial success of the pellets of Wiegand & Venuto.

Concurring opinion of Mr. Chief Justice Stone in

Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84.

Respondent has failed dismally in its attempt to evince that the commercial success of carbon black aggregates is attributable to Wiegand & Venuto.

Respondent's reference in DX-20, page 20, to the "exceedingly high shearing forces" available for dispersing the carbon, undoubtedly referred to the Banbury Mixer, which is an enclosed mixer (R. 31). With respect thereto Kitchel, respondent's president, testified (R. 43-44):

> "A. • • • instead of using dry rubber and dry materials on the open roll mills, they went to the use of the Banbury mixers and the charge of rubber is put in there and the door closed and it grinds out the mix and most of the effect is confined in that mixer.
>
> "Q. Do I understand you that the Banbury mixer is a closed mixer as compared to the open mill or mixer used previously?
>
> "A. That would be a common method of describing it.
>
> "Q. Going back again to this matter of the Banbury mixer, do you know approximately when the rubber companies began the use of the Banbury mixers?
>
> "A. I am not certain. I remember seeing them in use somewhere along in the early '30's, according to my best recollection."

Commercial success of carbon black granules or pellets followed the sale by the Cabot Company in the Fall of 1932, of *hard,* dense pellets made under the Billings & Offutt patents *by a dry process;* the shipment of such hard pellets in tank cars; and the installation by Cabot, at its own expense, in 1933 at the Firestone plant in Akron, Ohio (R. 149) of a closed conveyor system, and of a like system in another plant.

The consumer-resistance encountered by respondent and, as well, by Cabot, to the purchase of agglomerated

carbon black, is very substantial evidence that the carbon black dust problem was not as serious as respondent would have us believe.

Kitchel testified (R. 30, 31) that when respondent attempted to introduce the pellets of the Wiegand & Venuto process,

> "there appeared to be a tremendous lot of inertia by the consumers * * *".
> "* * * we found that our going was slower at that time than might be expected, * * *."
> "* * * the first year or two, or two or three years, was largely taken up with getting consumers to take a small lot and run their own experiment, * * *."

Respondent's brief (p. 18) so states.

Kitchel attributed some of the consumer resistance to the fact that

> "the Banbury mixer had come into use in the rubber industry." (R. 31)

The fact that Cabot charged no premium for its pelleted product, yet apparently found it necessary to install, free of charge, a closed conveyor system in the plants of two rubber companies for use with Banbury Mixers, is even further evidence that there was no insistent demand for carbon black in granular or pelleted form, and that the demand really came into being only after Cabot had demonstrated the advantages of its tank car shipments, and the handling in the rubber plants of hard pellets by conveyor systems.

Manifestly, there was no pressing demand on the part of the consumers for respondent's two-liquid product.

Perhaps one of the reasons therefor was the fact that that product was soft, as stated in the patent to Wiegand &

Venuto, and could not be readily handled. Petitioners' witness, Billings, testified (R. 152-153) that he had seen some of the product of Wiegand & Venuto that had been handled somewhat and it looked to him "like black scrambled eggs".

Furthermore, Doctor Drogin testified (R. 130) that he had made tests of the Wiegand & Venuto two-liquid pellets, represented by DX-13, and that he had found that the bulk or apparent density of that product was 17.6 pounds per cubic foot.*

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* Respondent attacks the production of pellets made by Dr. Drogin using Wiegand & Venuto's two-liquid process. That attack is unjustified. The patent to Wiegand & Venuto states (R. 229) at line 70 et seq., the proportions of the mix, and that in carrying out the process

> "* * * the mass may be thoroughly shaken or otherwise agitated for about five minutes and the resulting pellets will be of about one-sixteenth of an inch in diameter and will be fairly uniform in size."

No more definite instruction is to be found in the patent. Dr. Drogin used the specified proportions for his mix. He agitated the mass for about five minutes. And the resulting pellets were of about 1/16" in diameter and fairly uniform in size.

Respondent's attack is based primarily upon the fact that the weight of the pellets so produced was 17.6 pounds per cubic foot (R. 130). Yet the patent says (R. 228, lines 10-12)

> "carbon black, as manufactured, is such a very light, fine powder that no more than *ten pounds, or less,* occupy a package of one cubic foot."

At R. 229, lines 95-98, the patent states,

> "In shipping or storing, we find that approximately twice the number of pounds of these pellets can be placed in a container of a given size than is the case with the untreated carbon black."

Dr. Drogin started with carbon black having a density of about 12½ pounds per cubic foot (R. 175). Respondent indicates that the density and hardness of the pellets made would have been greater than 17.6 had greater agitation

Doctor Drogin further testified (R. 165) that a pellet black which bulks less than 20 pounds to the cubic foot is not quite suitable for commercial use or commerce.

Instead of evincing that the product of Wiegand & Venuto had any substantial or commercial success, it is believed that the record establishes that that product was a failure; was abandoned by respondent, and that instead of continuing to use the two-liquid process and to sell the product thereof, respondent became the sales agent for Columbian's water-alone product made under the Glaxner patent in accordance with the teachings of Geer and Knowlton & Hoffman; and that product, disparaged and discredited in the patent to Wiegand & Venuto, respondent has sold for the last decade.

To summarize: respondent's commercial success, if any, is in its sale of the product of the Glaxner process. To attribute that success to the product of the claims in issue, respondent is therefore obliged to construe the claims for the soft, spongy, porous product of the two-liquid process of Wiegand & Venuto to cover the product of the single-liquid, hard, dense, and relatively non-friable product of the Glaxner process. But, if that be in fact the proper scope and range of the claims in suit, they thereby inevitably fall athwart of the prior art product of Geer, Knowl-

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been used (R. 174-175). But Dr. Drogin used the Daisy Churn at a speed of 755 R. P. M. If greater agitation than that is essential, the patent does not so state.

Obviously, respondent's attack upon Dr. Drogin arises from the fact that the record discloses (R. 165) that pellet black weighing less than twenty pounds to the cubic foot is not suitable for commercial use or for commerce.

It follows that the attack upon Dr. Drogin is both unwarranted and unpardonable.

ton & Hoffman, and Coffin & Keen. If, on the other hand, the claims are limited to the product described and having the properties specified in the patent in suit, the product of the claims in suit manifestly had no substantial commercial success whatever.

The Claims in Issue as Now Construed by Respondent Are as Broad as the Original Claims Rejected and Cancelled in the Patent Office.

Original Claim 4 as amended by respondent and rejected by the Patent Office, (R. 360) read thus:

> (R. 358) "4. A pellet formed of substantially pure soft carbon black particles, the pellet being sufficiently hard to withstand ordinary shipment or handling, but readily breaking down to a fine state of subdivision upon the application of slight pressure."

Claims cannot cover what has been eliminated by rejection and cancellation. *Schriber Co. v. Cleveland Trust Co.*, 311 U. S. 220; *Exhibit Supply Co. v. Ace Corp.*, 315 U. S. 126.

Petitioners' Product Does Not Infringe the Claims in Suit.

The claims cannot cover petitioners' product without at the same time covering the product of the prior art.

Petitioners' product, like that of Geer and Knowlton & Hoffman, is a water-alone product;

Petitioners' mix is "dustless yet not pasty";

Petitioners' mix has the consistency of moist soil or loam (R. 101);

It is not as wet as paste (R. 100);

Petitioners' granules or pellets are not commercially uniform when produced.

They must be screened to obtain the desired sizes. (R. 102.)

Like the product of Knowlton & Hoffman, petitioners' product is strong enough to handle (R. 73).

Like the product of Knowlton & Hoffman, the friability of petitioners' product permits a uniform distribution of the carbon black throughout the rubber (R. 73).

Petitioners' process, like that of Knowlton & Hoffman, does not remove the grit (R. 108).

Petitioners' product does not have the porous interior called for by the claims in suit (R. 140).

If the claims in issue are confined to a product of the two-liquid process, or to the soft, easily crushed pellet described in the patent to Wiegand & Venuto, to escape the prior art, the claims leave petitioners' product untouched.

Conclusion.

Evidently realizing that if the product of the Wiegand & Venuto patent is soft and the product of the water-alone process used by the prior art and by petitioners is hard, respondent's product does not infringe the claims in suit, and that if the claims of Wiegand & Venuto here in issue are broad enough to cover respondent's product, the claims are wanting in novelty and invention over the prior art,—respondent seeks to escape the dilemma by purporting to find invention over the prior art in that the patent in suit states that the product thereof is "spongy or porous",

while Knowlton & Hoffman state that their product is "friable". Since "porosity causes friability" (R. 221), it would seem manifest that respondent seeks to escape the dilemma by resting its assertion of both novelty and invention upon a mere difference in words.

Respondent goes even further. It appears to make the contention that the product of the claims in suit were the result of inventive thought, in that the process of Wiegand & Venuto teaches the use of "agitation". But so did the prior art! Geer taught the use of a closed vessel which contains "rapidly-revolving paddles which assist the mixing and promote the attainment of the granular condition".

Respondent seeks to belittle the product of Knowlton & Hoffman by dubbing it "mudcake". That characterization, however, of the water-alone product of Knowlton & Hoffman, will not withstand examination. The water-alone product of Knowlton & Hoffman is produced from Geer's mix, which is the use of enough water to black, to make the mix "dustless and yet not pasty". To have the Court arrive at its "mudcake" conclusion with respect to Knowlton & Hoffman's product, respondent would have the Court wholly ignore the water-alone process and product of Knowlton & Hoffman.

The commercially acceptable carbon black pellets which are so widely used today, are the hard pellets of the prior art,—not the soft pellets of the patent in suit. Petitioners' product, made by the water-alone process, is not the product of Wiegand & Venuto. It is the product of Geer, and of Knowlton & Hoffman's water-alone process.

Petitioner's earnestly urge that the claims here in issue are invalid for want of both novelty and invention. Petitioners further urge that if the claims should be given a

narrow construction, in order to distinguish the product thereof from the prior art and the estoppels in the Patent Office, petitioners' product would not be within their scope.

Respectfully submitted,

HUGH M. MORRIS,
Attorney for Petitioners.

GEORGE P. DIKE,
ARTHUR M. SMITH,
OSMAN E. SWARTZ,
Of Counsel.